

REMARKS

The Office Action dated January 11, 2005, has been received and carefully noted. The amendments made herein and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 2 and 12 have been cancelled without prejudice and their subject matter incorporated into claims 1 and 11, respectively. Claims 1, 3, 11, 13, 14 and 15 have been amended. Applicants submit that the amendments made herein are fully supported in the specification and the drawings as originally filed, and therefore no new matter has been added. Accordingly, claims 1, 3-11 and 13-20 are pending in the present application and are respectfully submitted for consideration.

Allowable Subject Matter

As a preliminary matter, Applicants appreciate the indication of allowable subject matter in claims 2-5 and 12-15 of the present application. Independent claim 1 has been amended to include the allowable subject matter of claim 2, and independent claim 11 has similarly been amended to include the allowable subject matter of claim 12. Accordingly, Applicants submit that claims 1 and 11 are in condition for allowance.

Moreover, as claims 3-5 depend from claim 1, and claims 13-15 depend from claim 11, Applicants submit that each of these claims incorporates the patentable aspects therein, and therefore are also allowable.

Claims 6-10 and 16-20 Rejected Under 35 U.S.C. § 102(a)

Claims 6-10 and 16-20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Cook (U.S. Patent No. 6,343,505 B1, hereinafter "Cook"). Applicants

respectfully traverse the rejection and submit that each of these claims recites subject matter that is neither disclosed nor suggested by the cited prior art.

Claim 6 recites a method for determining leakage in an evaporated fuel processing system comprising, among other features, the step of determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value.

Claim 16 recites an apparatus for determining leakage in an evaporated fuel processing system comprising, among other features, means for determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value.

It is respectfully submitted that the prior art fails to disclose or suggest at least the above-mentioned features of the Applicants' invention.

The Office Action characterized Cook as allegedly disclosing "determining leakage by comparison of pressure values with predetermined values of pressure duration (e.g., Figure 1)." Applicants disagree with the Examiner's characterization of Cook, and therefore traverse the rejection.

Applicants submit that Cook fails to disclose or suggest each and every element recited in claims 6 and 16 of the present application. In particular, it is submitted that the automotive evaporative leak detection system of Cook is neither comparable nor analogous to the apparatus for detecting leakage in an evaporated fuel processing system of the present invention. In fact, Cook merely discloses a leak detection monitor

LDM (22, 222) for an on-board evaporative emission leak detection system that detects leakage from an evaporative emission space of a fuel system of an automotive vehicle. In one embodiment (22), Cook utilizes engine intake system vacuum to vent the evaporative emission space to atmosphere when the engine is running. In another embodiment (222), Cook utilizes an electromagnet actuator (270, 280). Neither embodiments disclose or suggest the step of determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value, or means for determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value recited in the present application. Therefore, Applicants submit that Cook fails to disclose each and every element recited in claims 6 and 16 of the present application.

Moreover, to qualify as prior art under 35 U.S.C. §102, a single prior art reference must teach, i.e., identically describe, each feature of a rejected claim. As explained above, Cook fails to disclose or suggest each and every feature of claims 6 and 16. Accordingly, Applicants respectfully submit that claims 6 and 16 are not anticipated by nor rendered obvious by Cook. Therefore, Applicants respectfully submit that claims 6 and 16 are allowable.

In addition, as claims 7-10 depend from claim 6, and claims 17-20 depend from claim 16, Applicants submit that each of these claims incorporates the patentable aspects therein, and are therefore allowable for at least the reasons set forth above with

respect to the independent claims, as well as for the additional subject matter recited therein.

Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 7-10 and 17-20 Also Recite Allowable Subject Matter

Applicants respectfully request that claims 7-10 and 17-20 should also be deemed to contain allowable subject matter. The outstanding Office Action dated January 11, 2005 indicated that claims 2-5 and 12-15 contain allowable subject matter, yet claims 6-10 and 16-20 were rejected under 35 U.S.C. § 102(a) as being anticipated by Cook (U.S. Patent No. 6,343,505 B1, hereinafter "Cook").

Applicants submit that the allowable subject matter recited in claims 2-5 are substantially similar to the subject matter recited in claims 7-10 and 17-20, and therefore claims 7-10 and 17-20 should also be deemed to contain allowable subject matter. In other words, since the Examiner has deemed the subject matter recited in claims 2-5 to be allowable, Applicants respectfully submit that the subject matter recited in claims 7-10 and 17-20 are also allowable.

Claims 1, 6, 11 and 16 Rejected Under 35 U.S.C. § 103(a)

Claims 1, 6, 11, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoff [sic] (JP 11-226,626, hereinafter "JP '626") in view of Shigihama (U.S. Patent No. 6,357,288, hereinafter "Shigihama"). In making this rejection, the Office Action took the position that JP '626 discloses substantially all of the elements of the claimed invention with the exception of "use of a computer program and prohibition of leakage determination if the detected pressure is outside a predetermined range."

The Office Action cited Shigihama for allegedly curing the deficiencies that exist in JP '626.

As a preliminary matter, claims 1 and 11 have been amended to incorporate the allowable subject matter recited in claims 2 and 12, respectively, and therefore the rejection is now moot.

As for claims 6 and 16, Applicants submit that neither JP '626 in view of Shigihama disclose or suggest the step of determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value, or means for determining whether the evaporated fuel processing system has leakage after the evaporated fuel processing system is closed based on the detected pressure and a predetermined determination value, recited in the present application. Therefore, Applicants submit that the cited prior art fails to disclose each and every element recited in claims 6 and 16 of the present application.

To establish *prima facie* obviousness, each feature of a rejected claim must be taught or suggested by the applied art of record. See M.P.E.P. §2143.03 and In re Royka, 490 F.2d 981 (CCPA 1974). As explained above, JP '626 in view of Shigihama, alone or in combination, do not teach or suggest each feature recited by pending Claims 6 and 16. Accordingly, for the above provided reasons, Applicants respectfully submit that pending Claims 6 and 16 are not rendered obvious under 35 U.S.C. § 103 by the teachings of JP '626 in view of Shigihama.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

Applicants respectfully request withdrawal of the rejection.


Conclusion

In view of the above, Applicants respectfully submit that each of claims 1, 3-11 and 13-20 recites subject matter that is neither disclosed nor suggested in the cited prior art. Applicants also submit that this subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore, respectfully request that claims 1, 3-11 and 13-20 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing docket number 108426-00041.**

Respectfully submitted,



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